



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,502	12/01/2003	Taihe Zhou	03WI0006US	1005
30781	7590	04/29/2005	EXAMINER	
PHILIP K. YU 20955 PATHFINDER ROAD SUITE 100 DIAMOND BAR, CA 91765			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/724,502

Applicant(s)

ZHOU ET AL.

Examiner

David C. Reese

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment: 3/23/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,8,12,16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,8,12,16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This office action is in response to Applicant's amendment filed 3/23/2005.

#### *Status of Claims*

- [1] Claims 4, 8, 12, 16, and 18 are pending.

#### *Specification*

- [2] Applicant has addressed all objections to the specification, including the abstract, in the amendment filed 3/23/2005. Accordingly, all objections to the disclosure have been withdrawn by the Examiner.

#### *Claim Objections*

- [3] Applicant has addressed all objections to the Claims in the amendment filed 3/23/2005. Accordingly, the Examiner has withdrawn the above objections to the claims. A new objection, however, has been warranted in the instant claims, as Claims 4 and 12 and are objected to under 37 CFR 1.75 as being a substantial duplicate of Claims 8 and 16, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
- [4] Also, in view of further examination and new findings, examiner has decided to withdraw the original objected claims (4, 8, 12, 16, 18) as being allowable subject matter, thus, as a result, the instant office action is non-final, and the reasons for such are discussed in the proceeding.

*Claim Rejections - 35 USC § 103*

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 4, 8, 12, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonakawa, US-5,528,909, in view of Ooide, US-2003/0154742.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 4, Tonakawa teaches of a bead chain, which comprises:

a plurality of beads (4 in Fig. 2) of a specific shape threaded onto a string or cord (1) to form a chain (Fig. 2);

a plurality of spacers (5) inserted between the plurality of beads (4) to form an alternating pattern (Fig. 2),

However, Tonakawa fails to disclose expressly that buttons are fixed at both ends of the string or cord disposed to join said bead chain, or wherein the outer surfaces of said spacers are engraved with characters, wherein said characters engraved on the outer surfaces of the spacers

Art Unit: 3677

are lections, and wherein said characters engraved on the outer surfaces of the spacers are Sanskrit or Tibetan characters and the corresponding Chinese characters of lections.

Ooide teaches of a bead chain that is joined by means of buttons fixed at both ends of the string or cord (Figs. 20, 31, and 34 of Ooide).

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the bead chain as taught by Tonakawa, to incorporate another embodiment of connectors as taught by Ooide, in order to create as Ooide states in paragraph [0008] a personal ornament that is maintained, "...with a stable frictional force, and which can be easily removed..."

As far as the characters are concerned (lections, Sanskrit, Tibetan, etc), note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). So, thus, in the instant case, the fact that the beads and spacers may have distinguishable characters imposed onto them, these claimed statements regarding the structure of the bead chain are given no patentable weight.

As for Claim 8 (see Claim objections and rejections above).

As for Claim 12, Tonakawa in view of Ooide disclose a bead chain, comprising:

a plurality of beads (4 of Tonakawa), each bead having a drilled through hole (2 of Tonakawa);

a plurality of spacers (5 of Tonakawa), each spacer having a drilled through hole (2 of Tonakawa);

a cord (1 of Tonakawa), said cord (1) being threaded through said through holes (2) of said beads (4) and spacers (5) to form a chain (Fig. 2 of Tonakawa), said beads (4) and spacers (5) being positioned in alternating pattern (Fig. 2 of Tonakawa);

a first connector at first end of said chain (100 in Fig. 31 of Ooide);

a second connector at second end of said chain (200 in Fig. 31 of Ooide);

wherein the outer surfaces of said spacers are engraved with characters,

wherein said characters engraved on the outer surface of the spacers are lections, and wherein said characters engraved on the outer surface of the spacers are Sanskrit or Tibetan characters and the corresponding Chinese characters of lections (As far as the characters are concerned (lections, Sanskrit, Tibetan, etc), note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). So, thus, in the instant case, the fact that the beads and spacers may have distinguishable characters imposed onto them, these claimed statements regarding the structure of the bead chain are given no patentable weight).

As for Claim 16, (see Claim objections and rejections above).

As for Claim 18, Tonakawa in view of Ooide disclose a bead chain, comprising:

a plurality of beads (4 of Tonakawa), each bead having a drilled through hole (2 of Tonakawa);

a plurality of spacers (5 of Tonakawa), each spacer having a drilled through hole (2 of Tonakawa);

a cord (1 of Tonakawa), said cord (1) being threaded through said through holes (2) of said beads (4) and spacers (5) to form a chain (Fig. 2 of Tonakawa), said beads (4) and spacers (5) being positioned in alternating pattern (Fig. 2 of Tonakawa);

a first connector at first end of said chain (100 in Fig. 31 of Ooide);

a second connector at second end of said chain (200 in Fig. 31 of Ooide);

wherein the outer surfaces of said spacers are engraved with characters,

wherein said characters engraved on the outer surface of the spacers are lections, and wherein the number of spacers corresponds to the number of words in a paragraph of lection (As far as the characters are concerned (lections, Sanskrit, Tibetan, etc), note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). So, thus, in the instant case, the fact that the beads and spacers may have distinguishable characters imposed onto them, these claimed statements regarding the structure of the bead chain are given no patentable weight).

Art Unit: 3677

*Conclusion*


[7] **THIS ACTION IS NON-FINAL**

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Examiner  
Art Unit 3677

  
ROBERT J. SANDY  
PRIMARY EXAMINER